

REMARKS

The Office Action mailed April 10, 2006, has been carefully considered. Reconsideration in view of the following remarks is respectfully requested.

Independent claims 1, 10, 13, 17, 18, 21, 25, 28, 29, 32, 36, 37, 40, 44, 45, 54, 57, 61, 62, 65, 69, 72, 73, 76, 80, 81, 84, 86, 89, 98, 101, 105, 106, 109, 113, 116, 117, 120, 124, 125, 128, 132, 133, 142, 146, 147, 151, 154, 155, 159, 160, 164, 165, 174, 178, 179, 183, 186, 187, 191, 192, 196, 197, 199, 201, 203, and 205 have been amended to further particularly point out and distinctly claim subject matter regarded as the invention. The text of claims 2-9, 11-12, 14-16, 19-20, 22-24, 26-27, 30-31, 33-35, 38-39, 41-43, 46-53, 55-56, 58-60, 63-64, 66-68, 70-71, 74-75, 77-79, 82-83, 85, 87-88, 90-97, 99-100, 102-104, 107-108, 110-112, 114-115, 118-119, 121-123, 126-127, 129-131, 134-141, 143-145, 148-150, 152-153, 156-158, 161-163, 166-173, 175-177, 180-182, 184-185, 188-190, 193-195, 198, 200, 202, 204, and 206 is unchanged, but their meaning is changed because they depend from amended claims.

The 35 U.S.C. § 102 Rejection

Claims 1, 2, 10, 13, 16-18, 21, 24-29, 32, 35-37, 40, 43, 45, 46, 54, 57, 60-62, 65, 68-73, 76, 79-81, 84, 87-90, 98, 101, 104, 105, 106, 109, 112, 114-117, 120, 123-125, 128, 131, 133, 134, 142, 145-147, 150-156, 159, 160, 163, 165, 166, 174, 177-179, 182, 183-187, 190-192, and 195 were rejected under 35 U.S.C. § 102(b) as being allegedly anticipated by Li.^{1 2} This rejection is respectfully traversed.

¹ U.S. Patent No. 5,774,588.

² Office Action dated April 10, 2006, ¶ 2.

According to the M.P.E.P., a claim is anticipated under 35 U.S.C. § 102(a), (b) and (e) only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.³

Claim 1 as presently amended recites:

A method for creating a keyword string database on a wireless user device, the method comprising:
determining one or more candidate keyword strings to store in said database;
creating one or more bit vectors based at least in part on said one or more candidate keyword strings, said one or more bit vectors for use in comparing an input bit vector with said one or more bit vectors to indicate whether an input keyword string represented by said input bit vector matches said one or more candidate keyword strings, said input vector provided by a user of said wireless user device; and
storing said one or more bit vectors and a reference to said one or more candidate keyword strings in said database.

The Examiner states:

As per claim 1, Li is directed to a method for creating a keyword string database (Li, Column 6 Line 10-21, i.e., “A Lexicon” and “An example of such a lexicon would be a list of city names in the United States, which could contain about 45,000 valid entries.”), the method comprising:
determining one or more candidate keyword strings to store in said database (Li, Column 6 Line 40-50, i.e. “valid lexicon strings (such as legal and correct city names).”);
creating one or more bit vectors based at least in part on said one or more candidate keyword strings (Li, Column 6 Line 40 through Column 9 Line 35), said one or more bit vectors for use in comparing an input bit vector with said one or more bit vectors to indicate whether an input keyword string represented by said input bit vector matches said one or more candidate keyword strings (Li, Column 9 Line 39 through Column 13 Line 62); and
storing said one or more bit vectors (Li, Column 7, Line 1-3, i.e. “Signature Vector”) and a reference to said one or more candidate keyword strings in said database (Li, Figure 2, “Store pointers to Lexicon Entries in Bucket Address Table” 240).⁴

With this Amendment, Claim 1 has been modified to recite in part “a method for creating a keyword string database on a wireless user device.” (emphasis added) Claim 1 has also been

³ Manual of Patent Examining Procedure (MPEP) § 2131. See also *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

modified to recite in part “said input vector provided by a user of said wireless user device.”

This amendment to Claim 1 finds support in the Specification at FIG. 2 and ¶ 14. These features are not found in Li. Accordingly, the Applicant respectfully submits the rejection of Claim 1 is unsupported by the art of record and must be withdrawn.

Dependent Claim 2

Dependent Claim 2 depends from claim 1. Claim 1 being allowable, Claims 2 must be allowable for at least the same reasons.

The Office Action states:

As per claim 2, Li is directed to the method of claim 1 wherein said bit vector further comprises at least one bit that represents a non-alphanumeric symbol (Li, Column 6 Line 43-47, i.e. “All lower case letters were mapped to their upper case letters, all between word spaces are stripped, and all non-alphanumeric characters are mapped to a selected specific non-alphanumeric characters (for example, “?”)”). It is inherent that those non-alphanumeric will be represented in the signature vector, which represents the original string. (Li, Column 7, Line 1-3, i.e. “Signature Vector”).

The Applicant respectfully disagrees with the Examiner’s statement that Li inherently disclosed wherein said bit vector further comprises at least one bit that represents a non-alphanumeric symbol. The Applicant respectfully submits that such conclusory allegations regarding the alleged inherency of the teachings are improper. According to the MPEP⁵, an Examiner must provide a rationale or evidence tending to show inherency. The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the

⁴ Office Action ¶ 2.

⁵ MPEP § 2112.

inherency of that result or characteristic.⁶ Furthermore, “In relying upon the theory of inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.”⁷

The Applicant respectfully suggests that the Examiner has failed to provide a basis in fact and/or technical reasoning to reasonably support the determination that wherein said bit vector further comprises at least one bit that represents a non-alphanumeric symbol necessarily flows from the teachings of Li.

Claims 10, 13, 16-18, 21, 24-29, 32, 35-37, 40, 43, 45, 46, 54, 57, 60-62, 65, 68-73, 76, 79-81, 84, 87-90, 98, 101, 104, 105, 106, 109, 112, 114-117, 120, 123-125, 128, 131, 133, 134, 142, 145-147, 150-156, 159, 160, 163, 165, 166, 174, 177-179, 182, 183-187, 190-192, and 195

With this Amendment, the independent claims of the present application have been modified to recite limitations corresponding to the modifications made to Claim 1. Claim 1 being allowable, Claims 10, 13, 16-18, 21, 24-29, 32, 35-37, 40, 43, 45, 46, 54, 57, 60-62, 65, 68-73, 76, 79-81, 84, 87-90, 98, 101, 104, 105, 106, 109, 112, 114-117, 120, 123-125, 128, 131, 133, 134, 142, 145-147, 150-156, 159, 160, 163, 165, 166, 174, 177-179, 182, 183-187, 190-192, and 195 must be allowable for at least the same reasons.

For the above reasons, the Applicant submits the rejection of claims under 35 U.S.C. § 102 should be withdrawn.

⁶ MPEP § 2112.

The First 35 U.S.C. § 103 Rejection

Claims 3-9, 47-53, 91-97, 135-141, and 167-173 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Li in view of Braun,^{8 9} This rejection is respectfully traversed.

According to the Manual of Patent Examining Procedure (M.P.E.P.),

To establish a *prima facie* case of obviousness, three basic criteria must be met. First there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in the applicant's disclosure.¹⁰

Claims 3-9, 47-53, 91-97, 135-141, and 167-173 depend from Claims 1, 45, 89, 133, and 165, respectively, and thus include the limitations of claim 1, 45, 89, 133, and 165. The arguments made above with respect to claim 1 apply here as well. The 35 U.S.C. § 102 rejection of claim 1 based on Li is unsupported by the art, as each and every element as set forth in claim 1 is not found in Li. Therefore, the 35 U.S.C. § 103 rejection of dependent claims 3-9, 47-53, 91-97, 135-141, and 167-173 based on Li in view of Braun is also unsupported by the art. Thus, no *prima facie* case of obviousness has been established and the 35 U.S.C. § 103 rejection should be withdrawn.

⁷ *Ex parte Levy*, 17 USPQ2d 1461 (Bd. Pat. App. & Inter. 1990) (emphasis in original).

⁸ U.S. Publication No. 2004/0064787.

⁹ Office Action ¶ 3.

¹⁰ M.P.E.P. § 2143.

Claims 4-9

The Office Action states:

Regarding Referring to claims 4-9, Official Note is taken that the concept of using symbols to represent/indicate other data is notoriously well known in the art. As such, it would have been obvious to a person of ordinary skill in the art to make non-alphanumeric symbols to represent/indicate email or mobile number or wired number or paper-mail address or cost ranking or quality ranking or a cuisine.¹¹

The Office action takes official notice of facts under M.P.E.P. § 2144.03 that the rationale supporting the obviousness rejection is based on common knowledge in the art or "well-known" prior art. Under M.P.E.P. § 2144.03, "[i]f the applicant traverses such an assertion the examiner should cite a reference in support of his or her position." Applicant hereby traverses the assertion and requests that a reference be cited in support of the position outlined in the Office Action.

The Applicant also reminds the Examiner that the recited limitations of Claims 4-9 are not merely "the concept of using symbols to represent/indicate other data" as the Examiner proposes. The Applicant requests the Examiner address the particular limitations recited by Claims 4-9.

The Second 35 U.S.C. § 103 Rejection

Claims 11-12, 14-15, 19-20, 22-23, 30-31, 33-34, 38-39, 41-42, 55-56, 58-59, 63-64, 66-67, 74-75, 77-78, 82-83, 85-86, 99-100, 102-103, 107-108, 110-111, 118-119, 121-122, 126-127, 129-130, 143-144, 148-149, 156-157, 161-162, 175-176, 180-181, 188-189, and 193-194 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Li in view of Albornoz et al.,^{12 13} This rejection is respectfully traversed.

¹¹ Office Action ¶ 3.

¹² U.S. Publication No. 2004/0260929.

The arguments made above with respect to claim 1 apply here as well. The 35 U.S.C. § 102 rejection of claim 1 based on Li is unsupported by the art, as each and every element as set forth in claim 1 is not found in Li. Therefore, the 35 U.S.C. § 103 rejection of dependent claims 11-12, 14-15, 19-20, 22-23, 30-31, 33-34, 38-39, 41-42, 55-56, 58-59, 63-64, 66-67, 74-75, 77-78, 82-83, 85-86, 99-100, 102-103, 107-108, 110-111, 118-119, 121-122, 126-127, 129-130, 143-144, 148-149, 156-157, 161-162, 175-176, 180-181, 188-189, and 193-194 based on Li in view of Albornoz et al. is also unsupported by the art. Thus, no prima facie case of obviousness has been established and the 35 U.S.C. § 103 rejection should be withdrawn.

Claim 12

The Office Action states:

Referring to claim 12, Official Note is taken that aborting/preempting a search process or any other process after a predetermined amount of time is notoriously well known in the art.

The Office action takes official notice of facts under M.P.E.P. § 2144.03 that the rationale supporting the obviousness rejection is based on common knowledge in the art or "well-known" prior art. Under M.P.E.P. § 2144.03, "[i]f the applicant traverses such an assertion the examiner should cite a reference in support of his or her position." Applicant hereby traverses the assertion and requests that a reference be cited in support of the position outlined in the Office Action.

¹³ Office Action ¶ 4.

The Third 35 U.S.C. § 103 Rejection

Claims 44, 88, 132, 164, and 196 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Li in view of Vagonzzi,¹⁴ among which claims 44, 88, 132, 164, and 196 are independent claims.¹⁵ This rejection is respectfully traversed.

Claim 44

With this Amendment, Claim 44 has been modified to recite in part “A method for incremental keyword search on a wireless user device” (emphasis added) Claim 44 has also been modified to recite in part “receiving from a user of said wireless user device an input keyword string comprising one or more words comprising one or more symbols, each symbol representing the first symbol of a word in a search string” (emphasis added) This amendment to Claim 44 finds support in the Specification at FIG. 2 and ¶¶ 14, 45, and 46. These features are not found in Li in view of Vagonzzi. Accordingly, the Applicant respectfully submits the rejection of Claim 44 is unsupported by the art of record and must be withdrawn.

Claims 88, 132, 164, and 196

With this Amendment, Claims 88, 132, 164, and 196 have been modified to recite limitations corresponding to the modifications made to Claim 44. The arguments made above with respect to claim 44 apply here as well. Claim 44 being allowable, Claims 88, 132, 164, and 196 must be allowable for at least the same reasons. Thus, no prima facie case of obviousness has been established and the 35 U.S.C. § 103 rejection should be withdrawn.

¹⁴ U.S. Patent No. 6,499,033.

The Fourth 35 U.S.C. § 103 Rejection

Claims 197-206 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Li in view of Ronchi et al.,¹⁶ among which claims 197, 199, 201, 203, and 205 are independent claims.¹⁷ This rejection is respectfully traversed.

Claim 197

With this Amendment, Claim 197 has been modified to recite in part “A method for comparing keyword strings on a wireless user device.” (emphasis added) This amendment to Claim 197 finds support in the Specification at FIG. 2 and ¶ 14. These features are not found in Li in view of Ronchi et al. Accordingly, the Applicant respectfully submits the rejection of Claim 197 is unsupported by the art of record and must be withdrawn.

Claims 199, 201, 203, and 205

As presently amended, Claims 199, 201, 203, and 205 contain limitations similar to Claim 197. Claim 197 being allowable, Claims 199, 201, 203, and 205 must be allowable for at least the same reasons.

Claims 198, 200, 202, 204, and 206

Claims 198, 200, 202, 204, and 206 depend from Claims 197, 199, 201, 203, and 205, respectively. Claims 197, 199, 201, 203, and 205 being allowable, Claims 198, 200, 202, 204,

¹⁵ Office Action ¶ 5.

¹⁶ U.S. Publication No. 6,496,836.

¹⁷ Office Action ¶ 6.

and 206 must be allowable for at least the same reasons. Thus, no prima facie case of obviousness has been established and the 35 U.S.C. § 103 rejection should be withdrawn.

In view of the foregoing, it is respectfully asserted that the claims are now in condition for allowance.

Conclusion

It is believed that this Amendment places the above-identified patent application into condition for allowance. Early favorable consideration of this Amendment is earnestly solicited.

If, in the opinion of the Examiner, an interview would expedite the prosecution of this application, the Examiner is invited to call the undersigned attorney at the number indicated below.

The Applicant respectfully requests that a timely Notice of Allowance be issued in this case. Please charge any additional required fee or credit any overpayment not otherwise paid or credited to our deposit account No. 50-1698.

Respectfully submitted,
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